

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Hong Lye Oh et al.
Application No. : 09/980,443
Filed : August 8, 2002
For : ADAPTIVE MOTION ESTIMATOR

Examiner : Jeremiah C. Huber
Art Unit : 2621
Docket No. : 851663.432USPC
Date : June 25, 2007

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION AND FOR ENTRY
OF AFTER-FINAL AMENDMENT

Commissioner for Patents:

The applicants hereby petition for withdrawal of the finality of the Office Action mailed February 23, 2007, and for entry of the Amendment filed May 23, 2007.

The finality of the February 23 office action is premature because the office action includes new grounds of rejection of claims 18-19. As recognized by the Examiner, the previous non-final office action dated May 16, 2006 did not include a rejection of claims 18-19. The present office action dated February 23, 2007 rejects claim 18 under 35 U.S.C. § 102 and rejects claim 19 under 35 U.S.C. § 103. While the Examiner believes that such new grounds of rejection presents no addition burden to the applicants, the applicants have had no previous opportunity to respond to the rejections based on the particular combination of elements presented in claims 18-19, which depend on claim 10. Accordingly, the applicants request withdrawal of the finality of the office action and entry of the present amendment.

A first non-final Office Action dated October 5, 2005 rejected original claims 1-13 as being either anticipated by U.S. Patent No. 5,557,684 to Wang et al. ("Wang") or obvious

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over Wang by itself or in view of one or more of U.S. Patent No. 5,428,396 to Yagasaki et al. (“Yagasaki”) and U.S. Patent No. 6,249,550 to Mizuno et al. (“Mizuno”). In response, the petitioners/applicants distinguished the prior art, without amending original claims 1-13, and added new claims 14-19.

A second Office Action dated May 16, 2006 rejected claims 1-17 as being either anticipated by UK Patent Application 2 208 774 to Morgan et al. (“Morgan”) or obvious over Morgan by itself or in view of one or more of U.S. Patent No. 5,428,396 to Yagasaki et al. (“Yagasaki”) and U.S. Patent No. 6,249,550 to Mizuno et al. (“Mizuno”). No rejections were made of claims 18-19. The second Office Action was properly made non-final because Morgan was a new reference and no amendments were made to claims 1-13. Thus, even if the Examiner had rejected claims 18-19, that rejection could not have been made final properly.

In response, the applicants filed an Amendment on November 16, 2006, which amended claims 8 and 10-11 and added new claim 20. No amendments were made to claims 18-19 and no arguments were directed to claims 18-19 because claims 18-19 were not rejected.

The final Office Action of February 23, 2007 rejected all of the pending claims, including claims 18-19. In particular, the Examiner rejected claim 18 as being anticipated by Morgan and rejected claim 19 as being obvious over Morgan in view of Yagasaki. The Examiner recognized that the rejections of claims 18-19 were new, but asserted that the final rejection of those claims presents no additional burden to the applicants because the claims recite only limitations that were present in other claims.

The Amendment filed May 23, 2007 requested reconsideration of the finality of the February 23 Office Action and submitted new claims 21-23. The Examiner issued an Advisory Action dated June 7, 2007 refused to enter the May 23 Amendment because of the new claims 21-23. The Examiner refused to withdraw the finality of the February 23 Office Action because “the individual limitations of the omitted claims 18 and 19 clearly correspond to limitations in the rejected claims 1 and 17 respectively, further no additional portion of Morgan were cited specifically to meet the limitations added by claims 18-19. Therefore, the Examiner maintains the position that no additional burden was placed upon the applicant by the absence of these rejections, and if the applicant wished to argue any of the limitations presented by claims 18 and 19, such arguments could have been raised in response to the corresponding claims.

The applicants hereby petition for withdrawal of the finality of the February 23 Office Action because the February 23 Office Action included new grounds of rejection of claims 18-19 that were not necessitated by any amendment or information disclosure statement filed by the applicants. As stated in MPEP § 706.07(a), “Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).” In view of the unchallenged fact that the February 23 Office Action includes new grounds of rejection of claims 18-19 that were not necessitated by any amendment or IDS by the applicants, the finality of the February 23 Office Action was premature.

The applicants respectfully disagree with the Examiner's reasons for making final the February 23 Office Action. First, it is immaterial whether 1) the individual limitations of the claims 18 and 19 correspond to limitations in other claims, 2) any additional portion of Morgan were cited specifically to meet the limitations added by claims 18-19; and 3) an additional burden was placed upon the applicants by the absence of these rejections. Neither MPEP § 706.07(a) nor any other portion of the MPEP or 37 CFR recognize those reasons as being justified reasons for making final an office action with new grounds of rejection.

Second, the individual limitations of claims 18 and 19 do not correspond to the limitations of claims 1 and 17, respectively, as indicated by the Examiner, or to the limitations of any other claims. Claim 18 depends on claim 10 which recites analyzing, selecting, and performing steps that are certainly not recited in claim 1 or in any claim that depends on claim 1. In addition, claim 18 further recites that the selecting step of claim 10 includes further steps. Given that claim 1 does not include the selecting step of claim 10, claim 1 cannot possibly include the further steps of that selecting step of claim 10. In other words, even if the further steps of claim 18 are similar to steps of claim 1, claim 1 does not recite that those further steps are part of a selecting step like that of claim 10.¹

¹ For conciseness, the applicants have not specifically addressed the details of claim 19, but similar considerations do apply to claim 19. That is, the combination of claims 10 and 19 recites limitations that are not found in the combination of claims 8 and 17.

Third, the Examiner new grounds of rejection of claims 18-19 do present an addition burden to the applicants. Quite simply, the applicants were unable to previously respond to the rejections of claims 18-19 because those rejections were not previously made. The additional burden is particularly high with respect to claim 19, because claim 19 was rejected in view of two references: Morgan and Yagasaki. In addition to being unable to previously argue that Morgan and Yagasaki do not teach all of the features of claims 10 and 19, the applicants were unable to previous argue that there was no motivation to combine Morgan and Yagasaki in the manner indicated by the Examiner in the final office action. Also, the applicants never had an opportunity to amend claims 18-19 to overcome Morgan and Yagasaki.

Accordingly, the finality of the February 23, 2007 Office Action is premature, and the applicants respectfully request the finality to be withdrawn and entry of the amendment filed on May 23, 2007.

The Director is authorized to charge any deficiency or credit any overpayment to our Deposit Account No. 19-1090.

Should the Director have any additional questions, he is respectfully encouraged to contact the undersigned attorney at (206) 622-4900.

Respectfully submitted,
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